

REMARKS

This Response is submitted in response to the Final Office Action dated June 22, 2005. In the Office Action, the Patent Office rejected Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over Greco et al. (U.S. Patent Pub. No. 2002/0120680 A1) in view of Heston (U.S. Patent Pub. No. 2002/0019741 A1).

By the present response, Applicant submits that the remarks and arguments below overcome the rejection by the Patent Office and places the application in condition for allowance. Notice to that effect is requested.

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over Greco et al. in view of Heston, Applicant submits that this rejection is improper for the reasons that follow.

In the Office Action, the Patent Office asserts:

Greco et al. teaches a method and system for providing electronic document services, comprising:

Claims 1 and 12,

providing a service provider server and user (client) computer...

providing a database accessible by the user...

inputting user unique information into the database via the user computer... utilizing demographic and/or geographical information...

selecting a type of communication by one of the users...

automatically delivering an item by one of said document-related services...[and]

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

However, Greco does not specifically teach that said forms include forms, which are used for creation [of] said document (communication).

Further, the Patent Office asserts that:

Heston teaches a method and system for performing legal services over the internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document.

However, independent Claim 1, as previously presented, requires a system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service. The system has a computer accessible site that automatically prepares the communication and provides for automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service.

Further, independent Claim 1, as previously presented, requires a computer that accesses a database that is remotely located with respect to the computer. The database stores the communication, stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the

communication and stores requirements to effect the delivery of the communication by the special service. Still further, independent Claim 1, as previously presented, requires the communication to be selected via the computer, automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service.

Independent Claim 12, as previously presented, defines a method for assisting with preparation and automatic mailing of a communication requiring delivery by a special service. The method has the steps of providing a computer-accessible site and providing a database accessible by a user via the computer-accessible site. The database is remotely located with respect to the user. Further, the database stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication.

Moreover, independent Claim 12, as previously presented, requires the step of inputting information into the database regarding demographics of the user wherein the requirements to

effect the delivery of the communication by the special service are based on the demographics of the user. Further, independent Claim 12, as previously presented, requires the steps of selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region. Still further, independent Claim 12, as previously presented, requires the steps of automatically mailing the communication, generating fees, postage costs, and special service mail provider costs, and automatically paying the fees.

In the Final Rejection, the Patent Office asserts, "Information as to special service is non-functional language and given no patentable weight." However, independent Claim 1, as previously presented, requires a system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service. Therefore, Applicant submits that special service is specifically defined and should be given patentable weight. Notice to that effect is requested.

In the Final Rejection, the Patent Office asserts, "Greco teaches a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to

processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051] said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084]".

Nowhere do *Greco et al.* teach or suggest a database that stores the communication, stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service as required by independent Claim 1, as previously presented. *Greco et al.* merely teach electronic document services that utilize a database that "may include multiple entries that contain a user identification data (ID) field 710 and user data field 720. The user ID field 710 may contain an identifier that uniquely identifies the user. The user data field 720 may include one or more subfields... a link information field 722, a service provider information field 724, and possibly a permissions field 726." Further, *Greco et al.* teach that the link information field 722 contains links to websites maintained by service providers, the service provider information field 724 contains

information about the type of service, etc. provided by service providers, and the permissions field 726 contains information about the permissive uses of services by each user. Therefore, Greco et al. do not teach or suggest a database that stores the communication, stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service as required by independent Claim 1, as previously presented.

In the Final Rejection, the Patent Office asserts, "Heston teaches that a client accesses a Website to select a document that he wants to prepare, and enters information necessary to create the document [0105]; [0025]; [0006]. As per mailing, Greco teaches this feature [0040].

Nowhere does Heston teach or suggest a system that has a computer accessible site that automatically prepares the communication and provides for automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service as required by independent Claim 1, as previously presented. Heston merely teaches a system and method for rendering legal services that utilizes a database for storage and access of user interface and

information that is manipulated by program logic. Further, the database stores legal forms and topical or legal area information. Therefore, Heston does not teach or suggest a system that has a computer accessible site that automatically prepares the communication and provides for automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service as required by independent Claim 1, as previously presented.

In the Final Rejection, the Patent Office asserts, "Greco teaches inputting user unique information into the database via the user computer; wherein services recommended are selected based on location e.g., city, state, country [0082]; [0084]; thereby indicating utilizing demographic and/or geographical information; selecting a type of communication by one of the users [0062]; [0084]; and automatically delivering an item by one of said document-related service [0069]".

Nowhere do Greco et al. teach or suggest the step of inputting information into the database regarding demographics of the user wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user as required by independent Claim 12, as previously presented. Greco et al. merely teach the service provider information field may be provided based on one or more

factors such as location (e.g., city, state, country, etc) [0082]; [0084]. Further, Greco et al. merely teach that the user may provide the document and identify the recipient of the document electronically to a secure location of a service provider operating in partnership with a delivery service. [0069] The service provider may be located in the locality of the recipient to facilitate the delivery of the document. [0069] Therefore, Greco et al. do not teach the step of inputting information into the database regarding demographics of the user wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user as required by independent Claim 12, as previously presented.

In the Final Rejection, the Patent Office asserts, "the motivation to combine modify Greco to include that said remote database, residing in said service provider server, includes forms which are used for creation of a document, as disclosed in Heston, would be to simplify a whole process of creation of a document and delivering it to a recipient".

Clearly, neither Greco et al. nor Heston, taken singly or in combination, teaches or suggests a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding



selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by independent Claim 1, as previously presented. Further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site, as required by independent Claim 1, as previously presented.

Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, as required by independent Claim 12, as previously presented. Further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the step of inputting

information into the database regarding demographics of the user via the computer-accessible site wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user, as required by independent Claim 12, as previously presented.

Still further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the steps of selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region, as required by independent Claim 12, as previously presented. Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the steps of automatically mailing the communication by the special service, generating fees and automatically paying the fees, as required by independent Claim 12, as previously presented.

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Greco et al.* with *Heston* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary

skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's system and method for automating delivery of a communication by a special service, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of Greco et al. and Heston in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine Greco et al. and Heston to produce the claimed invention. Therefore, *prima facie*

obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing, the rejection of Claims 1-18 under 35 U.S.C. §103(a), in view of *Greco et al.* and further in view of *Heston* has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-11 depend from Claim 1; and Claims 13-18 depend from Claim 12. These claims are also believed allowable since each sets forth additional structural elements and novel steps of Applicant's system and method, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Response; therefore, entry of this Response is proper and should be effected. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to

indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

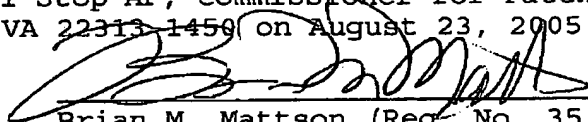


(Reg. No. 35,018)

Brian M. Mattson  
Patents+TMS  
A Professional Corporation  
2849 W. Armitage Ave.  
Chicago, Illinois 60647  
Telephone: (773) 772-6009  
Attorney for Applicant

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this **Response to Final Rejection and Transmittal Letter** are being transmitted via telefax (703)872-9306 to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA ~~22313-1450~~ on August 23, 2005.



Brian M. Mattson (Reg. No. 35,018)